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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,254	04/01/2004	Takumi Yoshida	58604-035	6949
20277	7590	06/13/2005	EXAMINER	
MCDERMOTT WILL & EMERY LLP			CULLER, JILL E	
600 13TH STREET, N.W.			ART UNIT	
WASHINGTON, DC 20005-3096			PAPER NUMBER	
			2854	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/814,254

Applicant(s)

YOSHIDA, TAKUMI

Examiner

Jill E. Culler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040730, 20041130
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although these appear to be method claims, they do not include any positively recited method steps and therefore the scope of the claim is unclear. For the purposes of furthering prosecution the claims are being treated as if a method step existed, positively reciting applying the coating material, but the claims must be rewritten to be properly examined.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,511,477 to Adler et al.

With respect to claim 1, Adler et al. teaches a coating material applying method for applying a coating material to a surface of a print, wherein said coating material is

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applied to said surface of said print by spraying said coating material thereto from a plurality of droplet spray nozzles, 6. See column 3, lines 28-38.

With respect to claim 2, Adler et al. teaches the coating material is an ultraviolet-curable coating material, said coating material being cured by emitting ultraviolet light to said print after applying said coating material to said print. See column 3, lines 45-46.

With respect to claims 3 and 5, Adler et al. teaches that an area for coating material application is determined as a particular area on said print, determined based on image data, said coating material being applied to said particular area by spraying said coating material selectively onto said particular area, forming an image on said print. See column 3, lines 36-41.

With respect to claim 6, Adler et al. teaches a coating material applying apparatus, 1, for applying a coating material to a surface of a print, comprising: a plurality of droplet spray nozzles, 6, for spraying said coating material on said surface of said print to apply said coating material thereto; and moving means, 2, for moving said print relative to said droplet spray nozzles. See column 3, lines 24-38.

With respect to claim 7, Adler et al. teaches that the coating material is an ultraviolet-curable coating material, said apparatus further comprising ultraviolet light emitting means for emitting ultraviolet light to said print after said droplet spray nozzles apply said coating material to said print. See column 3, lines 45-46.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 8-10, 12-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adler et al. in view of EP0782106 to Brand et al.

With respect to claim 4, Adler et al. teaches that the droplet spray nozzles are arranged transversely of said print, said coating material being applied selectively to said particular area by spraying said coating material from droplet spray nozzles

Adler et al. does not teach that the coating material is sprayed selectively from droplet spray nozzles corresponding to said particular area among said plurality of droplet spray nozzles.

Brand et al. teaches a coating material applying method wherein the coating material is applied using plurality of droplet spray nozzles, 10, wherein the coating material is sprayed selectively from droplet spray nozzles corresponding to said particular area among said plurality of droplet spray nozzles. See column 4, lines 22-41.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Adler et al. to spray from selected nozzles corresponding to a particular area, as taught by Brand et al., in order to more efficiently apply the coating material to the print.

With respect to claim 8, Adler et al. teaches area determining means for determining an area for coating material application as a particular area on said print;

Adler et al. does not teach control means for selecting droplet spray nozzles corresponding to said particular area from among said plurality of droplet spray nozzles, and causing said coating material to be sprayed from said droplet spray nozzles selected.

Brand et al. teaches control means for selecting droplet spray nozzles corresponding to said particular area from among said plurality of droplet spray nozzles, and causing said coating material to be sprayed from said droplet spray nozzles selected. See column 4, lines 22-41.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Adler et al. to provide control means as taught by Brand et al., in order to more efficiently apply the coating material to the print.

With respect to claim 9, Adler et al. teaches said area determining means is arranged to determine said particular area based on image data forming an image on said print. See column 3, lines 36-41.

With respect to claim 10, Adler et al. teaches a printing machine for performing printing based on image data, comprising: a transport mechanism, 2, for transporting a print; coating applying means including a plurality of droplet spray nozzles, 6, arranged perpendicular to a direction in which said print is transported by said transport mechanism, for spraying a coating material on said print transported; area determining

means for determining, based on said image data, an area for coating material application as a particular area on said print. See column 3, lines 24-41

Adler et al. does not teach control means for selecting droplet spray nozzles corresponding to said particular area from among said plurality of droplet spray nozzles, and causing said coating material to be sprayed from said droplet spray nozzles selected.

Brand et al. teaches control means for selecting droplet spray nozzles corresponding to said particular area from among said plurality of droplet spray nozzles, and causing said coating material to be sprayed from said droplet spray nozzles selected. See column 4, lines 22-41.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Adler et al. to provide control means as taught by Brand et al., in order to more efficiently apply the coating material to the print.

With respect to claim 12, Adler et al. teaches said area determining means is arranged to recognize an image area on said print from said image data, and determine said particular area to coincide with said image area. See column 3, lines 36-41.

With respect to claim 13, Adler et al. teaches said area determining means is arranged to determine said particular area as an area for coating material application on said print based on data inputted by an operator. See column 3, lines 36-41.

With respect to claim 14, Adler et al. teaches said coating material is an ultraviolet-curable coating material, said printing machine further comprising ultraviolet light emitting means disposed downstream of said coating applying means with respect

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to said direction in which said print is transported, for emitting ultraviolet light to said print. See column 3, lines 45-46.

Claims 15 and 17-19, are rejected with claims 10 and 12-14 respectively as the references teach using the claimed apparatus, which appears to be the purpose of these claims.

7. Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adler et al. in view of Brand et al. as applied to claims 4, 8-10, 12-15 and 17-19 above, and further in view of U.S. Patent No. 6,138,566 to Sakamoto.

With respect to claim 11, Adler et al. and Brand et al. teach all that is claimed, as in the above rejection of claims 4, 8-10, 12-15 and 17-19. Adler et al. also teaches platemaking means for making printing plates based on said image data. See column 3, lines 22-24.

Adler et al. and Brand et al. do not teach printing means for performing printing by using said printing plates.

Sakamoto teaches a printing press having platemaking means for making printing plates based on said image data and printing means for performing printing by using said printing plates. See column 1, lines 53-57.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the invention of Adler et al. as modified by Brand et al. with the invention of Sakamoto in order to be able to make and use printing plates in the same apparatus.



Claim 16 is rejected with claim 11 as the references teach using the claimed apparatus, which appears to be the purpose of this claim.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No., 2,868,166 to Brechenmacher, U.S. Patent No. 4,767,694 to Schubert, U.S. Patent No. 5,438,350 to Kerry, U.S. Patent No. 5,738,013 to Kellett, U.S. Patent No. 5,820,932 to Hallman et al. and U.S. Patent No. 6,083,571 to Kapfinger each teach an apparatus having apparent similarities to the claimed subject matter.

9.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (571) 272-2159. The examiner can normally be reached on M-Th 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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